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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,266	06/07/2001	John Brassil	1509-185	4601

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HEWLETT PACKARD COMPANY
P O BOX 272400, 3404 E. HARMONY ROAD
INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

EXAMINER

ELAHEE, MD S

ART UNIT PAPER NUMBER

2614

DATE MAILED: 06/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/875,266

Applicant(s)

BRASSIL ET AL.

Examiner

Md S. Elahee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-9, 17 and 18 is/are allowed.
- 6) ☒ Claim(s) 10-12 and 14-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Reopening of Prosecution-New ground of Rejection After Appeal

1. In view of the appeal Brief filed on 04/06/2006, PROSECUTION IS HEREBY REOPENED. The rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Response to Arguments

2. Applicant's arguments filed on 04/06/2006 Brief have been fully considered but they are moot in view of the new grounds of rejections and the following.

Regarding claim 10, the Applicant argues on page 20 that "appellants are not in a position to determine exactly how the examiner interprets the various steps of claim 10 vis-à-vis Rautila et al" and "In any event, it is clear that column 4, lines 33-54 and column 6, line 48-column 7, line 10 of the reference do not disclose the claim 10 requirement for the first communications device

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to place an order for an intended purchase with a supplier in response to payment authorization being received from a payment facility.” The examiner respectfully disagrees with this argument. In col.7, lines 2-6, **Rautila** discloses after receiving advertisement information including price of goods or services, mobile terminal [i.e., the claimed “first communications device”] user inherently decides for the intended purchase and makes a request for a form of payment for the purchase. In col.4, lines 33-54, col.6, line 48-col.7, line 10, **Rautila** further discloses after receiving payment authorization the user sends a payment [i.e., costing] request to a network server and after receiving payment, position transmitter transmits acknowledgement and provides permission to the user to have access to services. Since, the mobile terminal user made a payment request for the service and receives permission to have access for the service after making payment it is inherent that the mobile terminal placing an order for the intended purchase with the supplier using its second transceiver when payment authorization is received from the payment facility. Thus the rejection of the claim in view of **Rautila** remain.

Drawings

3. The drawings filed on 06/07/2001 are objected to under 37 CFR 1.83(a) because they fail to show a legend describing the labels on the Figures as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate

prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 12 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 12, the phrase “a similar communications device” is indefinite because it is unclear what the similar communications device is.

Regarding claim 14, the phrase “a similar communication device” is indefinite because it is unclear what the similar communication device is.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claim 10 is rejected under 35 U.S.C. 102(e) as being anticipated by **Rautila** et al. (U.S. Patent No. 6,549,625).

Regarding claim 10, with respect to fig.1,3 **Rautila** teaches a method of purchasing goods using a mobile terminal [i.e., first communications device] having a first transceiver for communication at a first data rate over a long range, and a second transceiver for communication at a second, higher data rate over a short range, the method comprising the steps of:

inputting details of an intended purchase into a memory provided in the mobile terminal [i.e., first communications device] (col.6, line 48- col.7, line 10, col.9, lines 12-42);

transmitting details of the intended purchase, using the second transceiver of the mobile terminal, to any similar, in-range transceiver which communicates at the second, higher data rate over a short range, any such similar transceiver being associated with a respective supplier (fig.1; col.6, line 48- col.7, line 10, col.9, lines 12-42);

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receiving, at the second transceiver of the mobile terminal, a communication from any such similar transceiver indicating that the intended purchase is available and indicating its cost (col.4, lines 33-54, col.6, line 48- col.7, line 10);

the mobile terminal communicating, upon receiving the communication from the supplier, with a payment facility using its first transceiver (col.4, lines 33-54, col.6, line 48- col.7, line 10);

the mobile terminal placing inherently an order for the intended purchase with the supplier using its second transceiver in response to payment authorisation is received from the payment facility (col.4, lines 33-54, col.6, line 48- col.7, line 10).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Rautila** et al. in view of **Kumar** et al. (U.S. Pub. No. 2002/0143634).

Regarding claim 11, **Rautila** teaches the payment facility communicating the cost of the intended purchase to a cash register associated with the user of the first communications device upon the goods input device communicating to the payment facility that the order has been made (col.6, line 48- col.7, line 10).

Rautila does not specifically teach a banking facility associated with the user of the first communications device. **Kumar** teaches a banking facility associated with the user of the first communications device (fig.1; page 4, paragraphs 0036-0040). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify **Rautila** to allow a banking facility associated with the user of the first communications device as taught by **Kumar**.

The motivation for the modification is to have doing so in order to provide the required transaction amount to the customer.

12. Claims 12 and 16 as best understood by 35 USC § 112 rejection are rejected under 35 U.S.C. 103(a) as being unpatentable over **Suzuki** et al. (U.S. 2005/0162939) in view of **Schiffer** (U.S. 6,871,063).

Regarding claim 12, with respect to fig.1-3,5,7 **Suzuki** teaches a digital portable phone (item 3, fig.1) [i.e., communications device] having a short-range wireless interface (item 16, fig.2; item 25, fig.5) [i.e., second transceiver] for communication at a second, higher data rate over a short range (page 4, paragraph 0069);

a communications device having music player, a memory, and a CPU 20 (fig.2) [i.e., processor] for controlling downloading of music files to the memory, and for transferring music files from the memory to the music player, the processor being programmed to control the second transceiver to request downloading of a given music file from a notebook (item 2, fig.1) [i.e., similar communications device] within the range of the second transceiver (fig.7; page 4, paragraphs 0069, 0071);

However, **Suzuki** does not specifically teach “a communications device having a first transceiver for communication at a first data rate over a long range”. **Schiffer** teaches a mobile phone (item 100, fig.1) [i.e., communications device] having a long-range transceiver circuit (item 102, fig.1) [i.e., first transceiver] for communication at a first data rate over a long range (fig.1; col.3, lines 32-33). Thus, it would have been obvious to one of ordinary skill in the art at

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the time the invention was made to incorporate a first transceiver of **Schiffer's** invention for communication at a first data rate over a long range in a communications device of **Suzuki's** invention in order to enable the portable phone of **Suzuki's** invention to send and receive calls via a long-range transceiver.

Regarding claim 16, **Suzuki** teaches a filter for enabling only selected [i.e., certain] music files from the similar communications device to be downloaded from the second transceiver into the memory (fig. 7; page 4, paragraph 0069).

Allowable Subject Matter

13. Claims 1-9, 17 and 18 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

Regarding claims 1 and 17, the prior art Rautila fails to teach initiating communication between the first communications device and the second communications device to establish whether or not the second communications device has data required by the first communications device and upon receiving confirmation that the second communications device has the required data, the first communications device using its first transceiver making a request to a service provider for a permission for the transfer of the required data from the second communications device to the first communications device.

14. Claims 14 is objected to as being dependent upon a rejected base claim, but would be allowable after overcoming 35 U.S.C. 112, first paragraph and second paragraph rejections, if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Since, claim 15 is dependent on claim 14, claim 15 is also objected.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Brassil et al. (U.S. 6,950,668) teach High data rate communication; and

Mousseau et al. (U.S. 6,438,585) teach System and method for redirecting message attachments between a host system and a mobile data communication device.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Md S Elahee whose telephone number is (571) 272-7536. The examiner can normally be reached on Mon to Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ME

MD SHAFIUL ALAM ELAHEE

June 21, 2006

A handwritten signature in black ink, appearing to read 'Wing Chan', with a stylized, flowing script.

WING CHAN
SENIOR PRIMARY EXAMINER
TECHNOLOGY CENTER 2800